REMARKS

Claims 27, 31 and 36 are pending in the application. Claims 31 and 36 have been amended. Claims 27, 31, and 36 remain pending. The amendments to the claims introduce no new subject matter.

I. Claim objections

Claim 36 has been objected to because of alleged informalities.

Applicants respectfully assert that the claim as amended clears up any informalities.

Applicants therefore request the withdrawal of the objection.

II. Claim Rejections – Non-statutory obviousness-type double patenting

Claims 27, 31 and 36 have been rejected under the judicially created obviousness-type double patenting.

Claim 27

Claim 27 has been rejected under the judicially created obviousness-type double patenting as allegedly being unpatentable over claim 1 of U.S. Patent No. 5,585,258.

Applicants respectfully traverse the rejection and its supporting remarks. The Examiner has asserted that "[w]here the ***patent specification*** particularly teaches that the entire NS3 domain polypeptide of amended claim 27 herein is a preferred embodiment of the patented claim 1, the subject matter of the currently amended claim 27 would be obvious to the artisan." (Page 3 of the Office Action dated 10/5/09, *emphasis added*) However, obviousness type double patenting is based upon whether the pending claims of the patent application are obvious over the claims of the issued patent. See, e.g., MPEP 804:

> "When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, ***the disclosure of the patent may not be used as prior art***. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992)." (emphasis added)

The Examiner cannot use embodiments in the specification that the Applicants taught as preferred as part of an obviousness type double patenting rejection.

Applicants respectfully request that the Examiner withdraw the rejection of claim 27.

Claim 31

Claim 31 has been rejected under the judicially created obviousness-type double patenting as allegedly being unpatentable over claim 5 of U.S. Patent No. 5,585,258 in view of Benson et al. U.S. Patent No. 5,258,496.

Applicants respectfully traverse the rejection and its supporting remarks. As with the rejection of claim 27, the Examiner has asserted that "[w]here the ***patent specification*** particularly teaches that the amino acid sequence of SEQ ID NO: 86 now described by claim 31 herein is a preferred embodiment of the patented claim 5, and Benson *et al.* teach that recombinantly-produced fusion proteins are ordinarily comprised in compositions during purification from a host cell wherein they are expressed, the subject matter of the currently amended claim 31 would be obvious to the artisan." (Page 4 of the Office Action dated 10/5/09, *emphasis added*) As discussed above, obviousness type double patenting is based upon whether the pending claims of the patent application are obvious over the claims of the issued patent. The Examiner cannot use embodiments in the specification that the Applicants taught as preferred as part of an obviousness type double patenting rejection.

Applicants respectfully request that the Examiner withdraw the rejection of claim 31.

Claim 36

Claim 36 has been rejected under the judicially created obviousness-type double patenting as allegedly being unpatentable over claim 1 of U.S. Patent No. 5,597,691.

Applicants respectfully traverse the rejection and its supporting remarks. As with the rejection of claim 27, the Examiner has asserted that "[w]here the ***patent specification*** particularly teaches that an assay for an inhibitor of the amino acid sequence of SEQ ID NO:86 should be conducted with the polypeptide of SEQ ID NO:86 and is a preferred embodiment of the patented claims, the subject matter of the currently amended claim 36 would be obvious to the artisan." (Page 4 of the Office Action dated 10/5/09, *emphasis added*) As discussed above, obviousness type double patenting is based upon whether the pending claims of the patent application are obvious over the claims of the issued patent. The Examiner cannot use embodiments in the specification that the Applicants taught as preferred as part of an obviousness type double patenting rejection.

Applicants respectfully request that the Examiner withdraw the rejection of claim 36.

III. Claim Rejections – 35 USC § 112, first paragraph, written description

Claim 36 has been rejected under 35 U.S.C. § 112, first paragraph, as allegedly claiming subject matter which was not disclosed in the specification in a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The amendment of claim 36 renders the rejection moot. As amended, claim 36 closely mirrors the Example 5. All that one of skill in the art need do to practice the invention is add a compound to see if the compound inhibits the observed proteolysis. Applicants respectfully assert that one of skill in the art would recognize that the Applicants had possession of the invention of claim 36.

Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 36.

IV. Claim Rejections – 35 USC § 112, first paragraph, enablement

Claim 36 has been rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking an enabling disclosure in the specification.

The amendment of claim 36 renders the rejection moot. As discussed above, claim 36 closely mirrors the Example 5. All that one of skill in the art need do to practice the invention is add a compound to see if the compound inhibits the observed proteolysis. Applicants respectfully assert that one of skill in the art would have no difficulty practicing the invention of claim 36.

Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 36.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 223002010004. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: March 26, 2010

Respectfully submitted,

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